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| EXAMINER | |
|---|---|
| OKEZIE, ESTHER O | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3652 | |

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/796,482 | MAESTAS, JEFFERY E. | |
| | Examiner | Art Unit | |
| | Esther O. Okezie | 3652 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *09 August 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) *5,7 and 14-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6,8-13 and 21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Amendment*

The amendment filed on 8/9/05 and the remarks presented therewith have been carefully considered. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 103*

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-4,6,8-10,12,13,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boozer in view of O'Kane et al and further in view of Markowitz.

3. Re claim 1, Boozer discloses an electromagnetic pick up tool comprising:

a handle (12) having a first compartment (18) for supporting a battery (30), a second compartment (44) for supporting a voltage regulator circuit (circuit board 42, fig 4, column 4, lines 1-46), and a cover for concealing and providing access to only the first compartment (32);

a shaft (106) having a proximal end mounted to the handle and a distal end, the haft being flexible and hollow (figs 5 and 16) ;

a light (216) mounted to the distal end of the shaft and coupled to the battery for illuminating objects in remote locations (figure 11; column 4, lines 52-66);

an electromagnet mounted to the distal end of the shaft and coupled to the battery for attracting and retaining magnetic objects thereon (120, 202);

a switch (51) for allowing a user to direct the tool toward an object to be retrieved without the tool being attracted to surrounding magnetic components.

Boozer discloses a flexible, bendable shaft (106) but does not disclose this shaft as telescopic. O'Kane discloses an illuminated magnetic pickup tool with a telescopic shaft (fig 4). It would have been obvious to one of ordinary skill in the art to make the shaft of Boozer telescopic as taught by O'Kane in order to extend or shorten the reach of the tool effectively and provide compact storage.

Although Boozer shows a flexible elongate wand (302; 201) that is bendable and deformable and able to fit in remote places providing two additional degrees of freedom (figure 16) and a universal ball and socket joint (197) in figure 7 connected to a mirror extending from the shaft to assist the user in long range applications, Boozer does not disclose a joint positioned in the shaft between a distal end of the shaft and the electromagnet. O'Kane et al discloses an illuminated magnetic pickup tool wherein a light (30) is located concentrically within the electromagnet, both are connected to a battery 18, and a ball joint (38) is interposed between the distal end of the shaft and the electromagnet (fig. 5). It would have been obvious to one of ordinary skill in the art to modify the shaft of Boozer to include a ball joint as taught by O'Kane in order to provide a more stable adjustment feature for bending the shaft to reach remote places.

Boozer discloses a hollow shaft containing electrical contacts (108 and 110) to provide power to the light and the electromagnet in both the collapsed and extended positions (column 5, lines 25-39; Also see figure 6). Boozer does not disclose "sliding and wiping" electrical contacts that are in contact with and movable relative to each

other in both the collapsed and extended telescopic positions. Markowitz discloses a telescopic extension cord/adjustably telescopic electric outlet including telescoping members that allow the user to extend the electrical outlet from the wall to a desired location. These telescoping members carry wipers or resilient conductive leaves (37 and 38) that "wipe" along the respective conductors (21 and 22) during "sliding" or extension of the telescoping members to urge constant electrical contact during extension and in effect providing "sliding and wiping" electrical contact during telescopic extension (see fig 2; col. 2, lines 44-67; col. 3, lines 34-45; col. 4, lines 1-11). It would have been obvious to one of ordinary skill in the art to modify the telescoping electromagnetic shaft of Boozer and O'Kane to include sliding and wiping contacts so that the conductors could effectively "slide" and "wipe" against each other during the extension of the telescoping parts in order to urge constant electrical contact as taught by Markowitz.

1. Re claim 2, Boozer discloses a fiber optic member (250) connected to a light bulb (216). This fiber optic member transmits light through the distal end of the electromagnet and is located concentrically within the tubular electromagnet (202, see figure 11).

4. Re claims 3, Boozer discloses the handle contains a 9-volt battery (30) for powering the device. Boozer does not disclose the batteries are rechargeable on a charging stand. It would have been obvious to one of ordinary skill in the art to modify the device of Boozer to include rechargeable batteries and a charging stand because rechargeable batteries are well known in the art.

5. Re claim 4, Boozer discloses terminal (63) in the handle (12) "may be connected to a remote source such as a vehicle electrical system through the cigarette lighter, or connected to a vehicle battery, as is known" (col. 4, lines 46-49).

2. Re claim 6, Boozer shows a flexible elongate wand (302; 201) that is bendable and deformable and able to fit in remote places providing two additional degrees of freedom (figure 16). Boozer does not disclose a joint positioned in the shaft between a distal end of the shaft and the electromagnet for providing at least one additional degree of freedom of movement with respect to the shaft.

O'Kane et al discloses an illuminated magnetic pickup tool wherein a light (30) is located concentrically within the electromagnet, both are connected to a battery 18, and a ball joint (38) is interposed between the distal end of the shaft and the electromagnet, allowing the light and electromagnet to swivel with respect to the shaft (fig. 5). It would have been obvious to one of ordinary skill in the art to modify the shaft of Boozer to include a ball joint as taught by O'Kane in order to provide a more stable adjustment feature for bending the shaft of the electromagnetic device to reach remote places.

3. Re claims 8-10, Boozer discloses the switch is a momentary, double-throw switch (58, column 4, lines 1-14, lines 53-61) and the switch has a first position wherein both the light and the electromagnet are off, a second position wherein only the light is on, and a third position wherein both the light and the electromagnet are on (switch 58, column 4, lines 1-14, lines 53-61) and the switch has a locking feature to alleviate a need for constant user engagement of the switch in each of the positions (column 4, lines 1-14, lines 53-61).

6. Re claims 12 and 21, Boozer discloses light emitting diodes or LED lights (56,57) located in the battery test circuit of the device to indicate a low battery condition. But, Boozer does not disclose the light located concentrically within the shaft of the electromagnetic device is a LED light, this light is an optical fiber tube (318). It would have been obvious to one of ordinary skill in the art to modify the device of Boozer to include LED lights located in the shaft of the device because LED lighting, as well as optical fiber lighting, is well known in the art.

7. Re claim 13, see the above paragraphs, as this claim is a combination of claims 1,3,4,6,8-10.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Boozer, O'Kane et al, and Markowitz as applied to claims 1-4,6,8-10,12,13,21 above, and further in view of Kaderabek. The combination of Boozer, O'Kane, and Markowitz does not show an additional magnet mounted to the handle and adapted to allow the pick-up tool to magnetically adhere to and be retained on a magnetic object. Kaderabek discloses an electric soldering iron tool with a magnetic plate (37) in the handle for mounting the tool on a metal surface. It would have been obvious to one of ordinary skill in the art to provide a magnet for mounting a tool to a surface as taught by Kaderabek in order to easily support the tool when not in use.

***Response to Arguments***

8. Applicant has argued that the prior art does not disclose 1) telescopic portions of the shaft including sliding and wiping electrical contacts mounted to the hollow shaft to provide power in the collapsed and extended positions; and 2) the use of rechargeable batteries on a charge stand.

In response, Markowitz discloses a telescopic extension cord/adjustably telescopic electric outlet including telescoping members that allow the user to extend the electrical outlet from the wall to a desired location. These telescoping members carry wipers or resilient conductive leaves (37 and 38) that "wipe" along the respective conductors (21 and 22) during "sliding" or extension of the telescoping members to urge constant electrical contact during extension and in effect providing "sliding and wiping" electrical contact during telescopic extension (see fig 2; col. 2, lines 44-67; col. 3, lines 34-45; col. 4, lines 1-11). In electrical applications that include telescopic features it would be obvious to one of ordinary skill in the art to utilize "sliding and wiping" electrical contacts to urge constant electrical contact during extension.

In response, Boozer does not disclose rechargeable batteries with a charging stand. Applicant should note rechargeable batteries are very well known in the art and utilized in numerous hand held tools.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Esther O. Okezie whose telephone number is (571) 272-8108. The examiner can normally be reached on Mon-Thurs 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EOO 10/30/05

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